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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,195	12/03/2001	Chris H. Senanayake	4821-409-999	4449
20582	7590	12/10/2003	EXAMINER	
PENNIE & EDMONDS LLP 1667 K STREET NW SUITE 1000 WASHINGTON, DC 20006			KUMAR, SHAILENDRA	
			ART UNIT	PAPER NUMBER
			1621	
DATE MAILED: 12/10/2003				

1 2

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/998,195	SENANAYAKE ET AL.
Examiner	Art Unit	
SHAILENDRA - KUMAR	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 07 October 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-73 is/are pending in the application.  
4a) Of the above claim(s) 9-31 and 44-73 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-8 and 32-43 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8, 9 . 6)  Other: \_\_\_\_ .

**DETAILED ACTION**

This office action is in response to applicants' communication filed in paper # 11, on 10/7/03.

Claims 1-73 are pending in this application.

1. Applicant's election with traverse of Group I, claims 1-8 and 32-43 in Paper No. 11 is acknowledged. No traversal ground has been mentioned, except that the applicants reserve the right to file divisional, continuation, or continuation-in-part application for the non elected claims 9-31 and 44-73.

The requirement is still deemed proper and is therefore made FINAL.

***Priority***

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 11/6/03 and 1/30/03 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 4-8, 32-39 and 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Jeffery et al (J. Chem. Soc., Perk Trans, 1, 1996, pp 2583-2589).

Jeffery et al, page 2583, column 2, compounds 4 and 5a, anticipates instant compounds and composition, when R is chlorophenyl.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-8 and 32-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeffery et al.

Jeffery et al teach structurally similar compounds and composition as claimed herein, see page 2583, compound 4 and 5a. The difference between the reference and herein claimed compound appears to be OH position in the compound. In herein, OH can be at position 3 also, whereas no such positional isomer has been taught in the reference.

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to obtain compounds within the generic structure of the reference, because the reference structure is structurally so similar to those claimed herein, except the OH position is different, with the reasonable expectation of achieving a successful composition, absent evidence to the contrary. Note that positional isomers are *prima facie* obvious. *In re Norris* (CCPA 1950) 179 F2d 970, 84 USPQ 458.

No claim is allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA - KUMAR whose telephone number is 703-308-4519. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Art Unit: 1621

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



SHAILENDRA - KUMAR  
Primary Examiner  
Art Unit 1621

S.Kumar  
12/8/03